

Raymond Moskaluk

7

REMARKS

Entry of the above-noted amendments, reconsideration of the Application, and allowance of all claims pending are respectfully requested. By this amendment, claims 1-3, 5-6, 8, 13-17, and 19-30 are amended, claims 4, 7, and 18 are canceled, and claims 31-33 are added. These amendments to the claims constitute a bona fide attempt by Applicant to advance prosecution of the Application and obtain allowance of the pending claims, and are in no way meant to acquiesce to the substance of the rejections. Support for the amendments can be found throughout the specification (e.g., in the published version of the Application, namely, *Moskaluk* US Pub. 2005/0018250, ¶ 28, 31, 36, 41-46, 49, and 54), drawings, and claims and thus, no new matter has been added. Claims 1-3, 5-6, 8-17, and 19-33 are pending.

Interview on June 18, 2007:

The amendments herein follow a telephone conference with the Examiner, the Examiner's Supervisor, and Applicant's Attorney on June 18, 2007 in which the claims, the specification, and the art of the record, including *Ostrover et al.* USP 6,585,154, were discussed. Positive discussion and consideration occurred during the telephone conference in connection with the claims presented herewith, including claim 1. Applicant understands the Examiner is formally filing an Interview Summary. The time and courtesy afforded Applicant's Attorney are gratefully acknowledged by Applicant.

Claim Rejections - 35 U.S.C. § 112, ¶ 2:

Claims 13 and 24 are rejected under 35 U.S.C. § 112, ¶ 2, as failing to provide antecedent basis for the limitation "said polycarbon memory". Without acquiescing in the rejection, Applicant respectfully submits the rejection is moot in view of the amendment herein of the cited recitation. Claim 13 presented herewith recites, *inter alia*: "wherein said computer-readable storage comprises one or more of polycarbon memory and/or mylar." Claim 24 presented herewith recites, *inter alia*: "wherein said second surface comprises one or more of a laser-readable polycarbon memory and/or mylar."

Claims 1-30 are questioned under 35 U.S.C. § 112, ¶ 2 for the use of the term "likeness" and the term is also stated to be indefinite. Without acquiescing in the rejection, Applicant respectfully submits the rejection is moot in view of the cancellation herein of the cited recitation.

Withdrawal of the § 112, ¶ 2, rejections is therefore respectfully requested.

Raymond Moskaluk

8

Claim Rejections - 35 U.S.C. §§ 102 and 103:

Claims 1-8, 14-18, and 25-30 are rejected under 35 U.S.C. §102(e) as being anticipated by Ostrover et al. (USP 6,585,154). Claims 9-13 and 19-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ostrover '154 in view of Official Notice. Without acquiescing in the rejections, Applicant respectfully submits the rejections are moot in view of the claim amendments presented herewith.

It is well-settled that there is no anticipation unless (1) all the same elements are (2) found in exactly the same situation and (3) are united in the same way to (4) perform the identical function. Since the Examiner's citations to each of the applied references are missing at least one element of each of Applicant's independent claims, Applicant respectfully submits that the claimed invention is not anticipated by the Examiner's citations to the applied references.

While Applicant does not acquiesce in the modification or combination of the Examiner's citations to the applied references, Applicant respectfully submits that the Examiner's citations to the applied references even so modified or combined, do not teach or suggest one or more elements of the claimed invention. The missing elements are neither well-known in the art nor mere predictable uses or variations of the cited prior art.

Applicant respectfully submits that the Examiner's citations to the applied references do not teach or suggest one or more elements of the claimed invention. A careful reading of the Examiner's citations to the applied references fails to set forth a sustainable basis that the references teach or suggest, for example, receiving a first photo-based image; printing a picture of said first photo-based image on a media; and placing an encoded representation of said first photo-based image on said media, wherein a reprint of said picture is obtainable by a reading of said encoded representation from said media, as recited in Applicant's independent claim 1. This point was discussed during the Interview.

Ostrover et al. '154 discloses:

For purposes of this specification and the accompanying claims the term "document" refers to any printed or written item containing visually perceptible data as well as to any data file which may be used to produce such a printed or written item. *Ostrover et al. '154*, col. 4, lns. 27-31.

...

The content of the document may contain, for example visual data including, but not limited to, text, at least one image, at least one color and at least one texture. *Ostrover et al. '154*, col. 4, lns. 44-46.

...

Raymond Moskaluk

9

System 20 includes a microchip 22 which includes a memory device capable of storing electronic data and a mechanism for affixation to a document. For purposes of this specification and the accompanying claims the terms "attached" and "affixed" are defined as physically attached to or in close proximity to. For example, a document pasted to a shipping carton and a microchip pasted to the same shipping carton are considered to be affixed one to the other even though there is no direct physical contact between them. Attachment may be, for example, by embedding, lamination or glueing. Microchip 22 may further include a status indicator which is readable by an operator of the system. Such a status indicator might indicate, for example, whether data has been entered into chip 22, whether the data has been altered, or whether chip 22 is full. Status may be indicated by, for example, a color change or an indicator light. *Ostrover et al.* '154, col. 4, ln. 66, to col. 5, ln. 14.

For purposes of this specification and the accompanying claims the term "photocopy machine" includes, but is not limited to, any device which functions to duplicate documents by processes such as photography or xerography.. *Ostrover et al.* '154, col. 5, lns. 53-56.

The basis of *Ostrover et al.* '154 disclosed as written text teaches away from the photo-based image recited in Applicant's independent claim 1.

The Office Action includes the following statement:

Regarding claims 9-13, 20-24, *Ostrover* discloses a microchip with a memory that is to be attached to a surface for representing a document printed on that surface.

It does not explicitly disclose the specific types of memories used.

However, the Examiner takes Official Notice on the use of different types of memories since they are common mediums used in data storage. *Office Action*, 05/17/07, pg. 6.

Applicant's claims 9-13 and 19-24 recite, *inter alia*, the following types of memory: a magnetic memory, a nonvolatile semiconductor memory, computer-readable storage that comprises an optically-readable code, a laser-readable memory, polycarbon memory, mylar, computer-readable memory, a laser-readable memory, optically-readable memory, a computer-readable memory chip, and a laser-readable polycarbon memory. Applicant understands the Official Notice is limited to the existence of the types of memory recited in claims 9-13 and 19-24; the Official Notice does not encompass other language of claims 9-13 and 19-24 or language of Applicant's claims, including former claims 1-8, 14-18, or 25-30 and current claims 1-3, 5-6, 8, 14-17, or 25-30.

For at least the reasons presented above with reference to claim 1, claims 1, 15, 19, and 25 are believed neither anticipated nor obvious over the art of record. The corresponding

Raymond Moskaluk

10

dependent claims are believed allowable for at least the same reasons as independent claims 1, 15, 19, and 25, as well as for their own additional characterizations.

Withdrawal of the §§ 102 and 103 rejections is therefore respectfully requested.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-3, 5-6, 8-17, and 19-33.

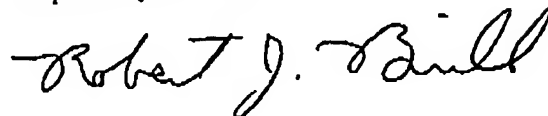
At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 C.F.R. 1.25. Additionally charge any fees to Deposit Account 08-2025 under 37 C.F.R. §§ 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Please consider this a general authorization to charge any fee that is due in this case, if not otherwise timely paid, to Deposit Account No. 08-2025.

Applicant hereby authorizes charging of Deposit Account No. 08-2025 for any additional fees associated with entering the aforementioned claims.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



Robert J. Brill
Registration No. 36,760
Direct Dial 312-876-2109
rjbrill@woodphillips.com

Dated: July 11, 2007

Attorney Docket No.: 200309921-1
(10375P00200US)

P.O. ADDRESS:

Hewlett Packard Company
PO Box 272400, 3404 E. Harmony Rd.
Intellectual Property Administration
Fort Collins, CO 80527-2400

Wood Phillips
500 W. Madison Street, Suite 3800
Chicago, IL 60661-2562
312-876-1800